

IN THE UNITED STATES DISTRICT COURT FOR THE
EASTERN DISTRICT OF WISCONSIN

COOPER INDUSTRIES, INC.,

Plaintiff,

v.

ASEA BROWN BOVERI INC. and
ABB INC.,

Defendants.

Civil Action 03-C-0723

Hon. Lynn Adelman
United States District Judge

ABB'S SUR-REPLY BRIEF ON CLAIM CONSTRUCTION¹

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¹ Where cited herein, Cooper's Reply Brief on Claim Construction is identified as "Cooper's Reply, p. ____;" Cooper's Opening Brief as "Opening Brief, p. ____;" and ABB's Brief on Claim Construction as "ABB's Brief, p. ____." The Exhibits submitted by Cooper are cited herein as "Cooper Exhibit __, p. ____."

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INTRODUCTION

In accordance with the discussion with the Court during the telephonic status conference on April 27, 2004, ABB respectfully submits this Sur-Reply Brief to address several new issues raised in Cooper's Reply Brief and in Cooper's two new "expert" declarations filed therewith.

The telltale flaw in Cooper's entire claim construction argument in this case is set forth in the first paragraph of Cooper's Reply Brief, where Cooper charges that ABB is "baiting" the Court to focus on what Cooper calls "meaningless prosecution history." In reality, apart from the patents-in-suit, the prosecution histories of the patents-in-suit are the only *probative* intrinsic evidence available to assist the Court in construing the claims of the patents-in-suit—if they can be construed. Cooper focuses on *extrinsic* evidence when it is the *intrinsic* evidence that the Court must first consult in attempting to construe Cooper's patent claims.

Also, although Cooper tells the Court that "razor-thin precision is required" in claim construction (Cooper's Reply, p. 27), Cooper uses fuzzy language and very broad brush strokes to obfuscate, rather than clarify, the "boundaries" or "fences" surrounding its alleged inventions, *i.e.*, the meanings of its patent claims. For example, Cooper says "food grade dielectric fluid" should be construed to mean "a dielectric fluid that is composed of substances having *non-toxic* and *non-biologically hazardous* qualities making them suitable for use in food or food processing." Cooper's Reply, p. 6. This is anything but "razor-thin precision." What *are* these non-toxic and non-biologically hazardous "qualities" which are nowhere defined in the patents-in-suit or their prosecution histories? How could one of ordinary skill in the relevant art in 1995 have known whether a dielectric fluid was or was not "suitable for use in food or food processing?" And, more glaringly, how can Cooper contend that "non-toxic" and "non-biologically hazardous" shed *any* light on what "food grade" might have meant in 1995 to those

of ordinary skill in the field of dielectric fluids for electrical equipment given that the Patent Office previously rejected those very terms, respectively, as indefinite and anticipated by prior art. In other words, Cooper advances as a construction of "food grade" the very terms that the PTO Examiners found to be inadequate.²

I. Cooper's proposed construction of "Food Grade Dielectric Fluid" contradicts the intrinsic evidence and seeks to impermissibly recapture what Cooper expressly disclaimed in the Patent Office.

In the guise of claim construction, Cooper asks the Court to give back to Cooper what Cooper surrendered in the Patent Office in order to obtain its patents-in-suit. At the Examiner's insistence, Cooper *deleted* the "non-toxic" limitation from Cooper's claims because the Examiners found the term "non-toxic" to be indefinite in view of Cooper's failure to disclose any defined standards of non-toxicity:

In claims 10, 18, 34 and 46, line 3, "a non-toxic dielectric insulating fluid" is not defined since the specification does not provide any criteria or reference to any recognized environmental or technical standards to qualify and quantify the acceptance of the fluid as being non-toxic and one skilled in the art with which it pertains, or with which it is most nearly connected would not be able to make and/or use the invention.

Cooper Exhibit 3, p. C000307 (emphasis added). Thus, the Examiner rejected "non-toxic" for lack of quantitative specificity. In order for the term "food grade" to have then satisfied the Examiner, the term "food grade" must have been understood to refer to quantity.

In addition, in all claims of the '537, '986, and '250 patents, the term "food grade" modifies "dielectric fluid" and not merely certain ingredients of the dielectric fluid. Cooper, however, urges the Court, in construing the term "food grade dielectric fluid," to focus not on the

² Cooper is continuing its quest for nebulous claims in the PTO even now. In published U.S. Patent Application Serial No. 10/619,893, Cooper is seeking claims similar to those in the '459 patent but in which the limitation "wherein the dielectric fluid is essentially a natural food product" is replaced with "wherein the dielectric fluid is environmentally safe." ABB expects that if this patent issues in the near future, Cooper will seek to add it, with those meaningless claims, to this suit.

dielectric fluid, but on the individual components of the dielectric fluid. Cooper's Reply, p. 6 ("Cooper proposes that the term 'food grade dielectric fluid' as used in the '986 and '250 patents should be defined to mean: 'a dielectric fluid that is composed of substances having non-toxic and non-biologically hazardous qualities making them suitable for use in food or food processing.'"). Cooper's proposed construction is flawed in a number of ways.

First, Cooper explicitly disclaimed this proposed construction. See August 10, 1998 amendment after final rejection (Cooper Exhibit 3, p. C000338) ("While the Examiners suggested specifying that the antioxidant [sic, antioxidant] is essentially food grade, Applicants have opted to set forth that the dielectric fluid is essentially food grade.") (emphasis and clarification added). Thus, Cooper narrowed its claims, beyond what the Examiners allegedly suggested, to require not only that the antioxidants or additives be food grade but that the entire dielectric fluid be "food grade." Having done that, Cooper cannot now recapture, under the guise of claim construction, the claim scope that Cooper explicitly disclaimed. Specifically, Cooper cannot convert its "food grade dielectric fluid" recitation into "food grade antioxidant" or "food grade additive" as it asks this Court to do.

Cooper also asks the Court to construe "food grade" by reference to quality but not quantity, which also is inconsistent with the prosecution history of the patents-in-suit. Cooper expressly argued that if a dielectric fluid includes components other than vegetable oil, "the amount and/or character of the non-vegetable oil components must be carefully selected to preserve the environmentally safe nature of the fluid (page 7, line 19 to page 8, line 1)." See February 27, 2001 Brief on Appeal (Cooper Exhibit 9, pp. C000824-C000825) (emphasis added).

Cooper also asks the Court to ignore the statements Cooper made in the prosecution history regarding substances that, if added to a dielectric fluid, render that dielectric fluid non-food-grade. For example, in arguing that its patent claims distinguished from the Sato '824 prior-art reference, Cooper argued that "The aromatics, which have ring structures related to benzene, are well known to be toxic and non-biodegradable, and, if used as an additive in the dielectric fluid of the invention, would be expected to alter its food grade character." Thus, Cooper presented a general argument with respect to all aromatics, pointing out that they "have ring structures relating to benzene" and "are well known to be toxic and non-biodegradable." Brief on Appeal, p. 8 (Cooper Exhibit 9, p. C000828). In support of that argument, Cooper cited a chemical dictionary which describes the hazardous nature of "benzene" as follows: "**Hazard: A carcinogen. Highly toxic.** Flammable, dangerous fire risk. Explosive limits in air 1.5 to 8% by volume. TLV: 10 ppm in air." Cooper Exhibit 9, pp. C000828 and C000844 (emphasis added). Cooper could have articulated a distinction among different *types* of aromatics, as Cooper now asks this Court to do, but Cooper did not do so. The intrinsic record therefore gives no indication to competitors, or the public at large, or to this Court that only certain types of aromatic compounds "would be expected to alter [the] food grade character" of a dielectric fluid. Cooper has identified no such indication in the intrinsic record because there simply is none.

Cooper's Reliance on the Food Chemicals Codex (FCC) is misplaced. The Food Chemicals Codex is not probative of what "food grade dielectric fluid" means. The FCC deals only with individual ingredients—not compositions made up of multiple ingredients in combination. Moreover, every such "ingredient" discussed in the FCC is a specific substance with a known chemical formula. For example, the FCC does discuss individual, specific antioxidants such as TBHQ. The FCC does not, however, discuss generic *categories* of

substances such as antioxidants. That is one reason why the generic category "dielectric fluid" is not something that the FCC addresses. In fact, there is no discussion at all in the voluminous FCC about "dielectric fluids."

According to the FCC itself, the specifications contained in the FCC are trumped by applicable FDA regulations, which Cooper admits would be considered by one of ordinary skill in the art. Cooper's Reply, page 11-12. Cooper admits that "the term 'food grade' does require compliance with FDA concentration limits for edible foods." Cooper's Reply, page 38. Cooper did not refer to the FCC in the applications for the patents-in-suit, did not disclose the FCC to the Patent Office during prosecution of those applications, and did not provide any specification or explanation whatsoever, whether in its patent applications or during the prosecution thereof, of what "food grade" means in the context of the dielectric fluids for electrical equipment. Indeed, Cooper did not even mention the term "food grade" in the first patent applications that it filed. When Cooper finally did add the term "food grade" in its CIP application (which issued as the '986 patent), the only instance where "food grade" appeared related to a blend of vegetable oils, which obviously connotes the edible nature of the vegetable oil blend.

II. The Federal Circuit has ruled that patent claims found to be insolubly ambiguous must be held to be indefinite as a matter of law.

ABB agrees that this proceeding is limited to claim construction, and, contrary to Cooper's arguments, ABB has not moved for summary judgment. However, one proper outcome following the Court's claim construction analysis is for the Court to determine—in this claim construction proceeding—that the claims are insolubly ambiguous and cannot be clearly and definitely construed. The Federal Circuit has held that if the Court makes that determination, the appropriate course is for the Court to hold the claims to be indefinite as a matter of law rather than attempting to construe them. *Honeywell Int'l. Inc. v. Int'l Trade*

Comm'n, 341 F.3d 1332 (Fed. Cir. 1994). One District Court that was unable to construe a claim limitation in view of the specification of the subject patent included in its Claim Construction Order an invitation to the Defendants to file a motion for summary judgment that the claim term is indefinite and thus the relevant claims are invalid under 35 U.S.C. § 112, ¶2. *Acacia Media Technologies Corporation v. New Destiny Internet Group, et al.*, 2004 U.S. Dist. LEXIS 13415 (C.D. Cal. 2004) ("Federal Circuit case law allows a district court to address validity under 35 U.S.C. § 112, ¶2 during claim construction." (fn. 16); "Determining whether a claim is definite requires an analysis of whether one skilled in the art would understand the bounds of the claim when read in light of the specification.... If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more. (p. *61)). To the extent that such a determination must be supported by clear and convincing evidence, as Cooper suggests, as explained in detail in ABB's Brief, the intrinsic record in this case (*i.e.*, the patent applications, the prosecution histories, and the prior art) constitutes clear and convincing evidence.

Cooper's suggestion that ABB's indefiniteness argument comes as a "surprise" is disingenuous. ABB advised Cooper's counsel on several occasions—long before Cooper filed its Opening Brief—that ABB would advise the Court of the insoluble ambiguity of Cooper's patent claims and the Court's ability to hold the claims invalid as a matter of law in the context of this claim construction proceeding. *See, e.g.*, ABB's Supplement to its Submission Regarding Claims in Dispute, filed February 17, 2004.

III. Cooper's proposed claim constructions come from "thin air."

Cooper has pointed to no evidence in the intrinsic record that supports Cooper's proposed claim constructions. Even the declarations of Cooper's new alleged "experts," which are entirely *extrinsic* "evidence," provide no substantive support for Cooper's assertion that Cooper's

proposed claim constructions are correct.³ Jacob Angelo⁴, for example, states that “[t]he difficult technical issue addressed in the Cooper patents were how to formulate an electrical insulating oil composition that would meet required specifications for such oils while, at the same time, maintaining ‘essentially food grade’ or ‘food grade’ properties. [. . .] The inventors had to address and overcome these problems to achieve their invention, and how the inventors did so is the focus of the Cooper patents.”

If it were true, as Cooper claims, that “maintaining ‘essentially food grade’ or ‘food grade’ properties” was a “difficult technical issue” that the Cooper inventors faced (and allegedly “solved”), one would expect the Cooper patents to explain that problem and solution—or at least mention it! But Cooper’s patents do not. They are utterly silent on this so-called “difficult technical issue.” Cooper’s first three patent applications do not mention the term “food grade” at all. This, by itself, is clear and convincing evidence that Cooper did not consider “food grade dielectric fluid” to be its invention until the Patent Office rejected every other claim strategy Cooper tried. Even at that time, it was not Cooper or its inventors, but the PTO Examiners, who suggested the “food grade” verbiage.

Likewise, Cooper did not define or even mention the term “essentially food grade dielectric fluid” in its earliest patent applications. Now Cooper asks the Court to construe that term to mean “a dielectric fluid that is *mostly but not entirely* composed of substances having non-toxic and non-biologically hazardous qualities making them suitable for use in food or food

³ Most of the “evidence” relied on by Cooper relates not to the patents-in-suit, but to ABB products developed years later. Such extrinsic evidence has no bearing on claim construction. On the other hand, Cooper identifies no support in the intrinsic record for its claim construction positions.

⁴ The Declaration of Jacob B. Angelo should be disregarded or stricken by the Court as untimely. Cooper admits that it retained Dr. Angelo long before it filed its Opening Brief. See Cooper’s Reply, fn. 12 (claiming Cooper sought out ABB’s expert, Dr. Thomas O. Rouse, when Dr. Angelo and Dr. Liotta had “possible scheduling conflicts”). Cooper thus withheld Dr. Angelo’s Declaration from its opening brief to deprive ABB of an opportunity to respond to it.

processing.” Cooper says “this definition harmonizes the plain language of the ‘537 patent claims with the intrinsic record” (Cooper’s Reply, p. 15). But Cooper provides no support in the intrinsic record for this attorney argument or for its proposed construction. Why? Because there is no such support. Cooper’s proposed claim construction adds no clarity or definiteness.

“Non-toxic” was a claim term rejected by the PTO as indefinite. Further, *how much* of a composition constitutes “mostly but not entirely?” 51%? 60%? 67%? 75%? 80%? 90%? 99%? 99.9%? 99.999%? This term is not explained or defined in the specification of the ‘537 patent or anywhere else in the intrinsic record. The public is left to guess, and so is this Court.

Cooper’s proposed “mostly but not entirely” construction also fails to distinguish Cooper’s patent claims from the prior art. For example, the prior-art Sato ‘824 reference discloses dielectric fluid composed of as much as 99.999% edible vegetable oil and as little as 0.001% additives. United States Patent No. 4,734,824 (Sato), column 7, lines 24-28 (Exhibit 12). Even if the additives of Sato are toxic, the dielectric fluid of Sato is certainly “mostly but not entirely (99.999%) composed of substances having non-toxic and non-biologically hazardous qualities making them suitable for use in food or food processing.” Thus, if Cooper’s claim construction is adopted, then Cooper’s claims squarely read on and are invalid over at least the prior-art Sato ‘824 patent.

In this context, “essentially” cannot mean “almost” because that would not make any sense. Cooper defines “food grade” with reference to “non-toxic” and “non-biologically hazardous.” Under Cooper’s proposed construction, then, “essentially food grade” would mean “essentially non-toxic” and “essentially non-biologically hazardous.” But something that is “essentially non-toxic” is still toxic, and something that is “essentially non-biologically hazardous” is still biologically hazardous. Cooper’s proposed construction of the term

"essentially," in this context, is not apt. For example, consider the terms "non-pregnant" and "non-alive." A woman cannot be characterized as "essentially non-pregnant" or as "essentially non-alive." Context must be considered. Either the dielectric fluid is "food grade" (whatever that term may mean, if anything), or it is not.

"Essentially food grade dielectric fluid" therefore must mean either that the overall dielectric fluid *necessarily* is "food grade" or that the primary characteristic of the dielectric fluid is "food grade" (*i.e.*, edible by humans).

IV. Dr. Angelo misrepresents Dr. Rouse's statements.

In paragraph 16 of his Declaration, Dr. Angelo states:

I agree with Dr. Rouse's suggestion that, as of 1995, it was unlikely that anyone in the field of dielectric fluids for electrical equipment would consider using "food grade" substances in a dielectric fluid (see Rouse Dec. ¶15).

This is a misrepresentation of what Dr. Rouse actually said. Paragraph 15 of Dr. Rouse's Declaration states:

The Cooper patents-in-suit do not, in my opinion, give a precise definition of the terms "food grade" or "essentially food grade" for a dielectric fluid. The term "food grade" might be interpreted to mean any number of things, such as: "edible by humans;" "usable in preparation of food edible by humans;" "suitable as plant food;" "usable in preparation of plant food;" "edible by aquatic or marine creatures;" "usable in preparation of food edible by aquatic or marine creatures;" "edible by non-human animals;" or "usable in preparation of food edible by animals." The term "food grade" also might be a reference to whether a substance is legally authorized (for example by the FDA, the USDA, or another relevant governmental agency) to be used in food (for humans or otherwise). What is clear, in my opinion, is that the term "food grade" in or about 1995 had no definite meaning to persons of ordinary skill in the field of dielectric fluids for electrical equipment. Indeed, it is unlikely that anyone in that field would even consider a term like "food grade" as a basis for evaluating dielectric fluids because, as I mentioned above, no one would have contemplated using dielectric fluid as food, just as no one would consider using transmission fluid or windshield wiper fluid or cleaning fluid as food (underlining added).

V. Cooper mischaracterizes ABB's marketing materials.

Cooper suggests that ABB "describes its BIOTEMP fluid as a "Renewable Natural Agricultural Product" (Cooper's Reply, p. 39). To the contrary, the document that Cooper cites to support that misrepresentation (Cooper Exhibit 59) says only that the "Source" (*i.e.*, the vegetable oil *base* fluid) is a renewable natural agricultural product. ABB's synthetic oxidation inhibiting additives are *separately* described in Cooper Exhibit 59 and those ingredients cannot be "renewable natural agricultural products." Even in the documents cited by Cooper where ABB uses the term "food grade," ABB distinguished between "food grade" and "food contact grade" and used "food grade" only in relation to antioxidants or inhibitors—not in relation to dielectric fluid, where the term makes no sense.

VI. The patents-in-suit were not carefully examined.

Cooper suggests the patents-in-suit underwent a "thorough and complete" examination in the Patent Office (Cooper's Reply, p. 14). The intrinsic evidence suggests otherwise. For example, in the '459 patent, claims 19 and 27 are identical in scope and at least one should have been rejected on that basis. *See* 37 C.F.R. § 1.75(b) ("More than one claim may be presented provided they differ substantially from each other. . ."). The more significant defect is that the claims do not comply with 37 C.F.R. § 1.75(d), which requires that "[t]he claim or claims must conform to the invention as set forth in the remainder of the specification and *the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description* (See § 1.58(a).)" Because the terms "food grade dielectric fluid" and "essentially food grade dielectric fluid" find no support or antecedent basis at all in the description (*i.e.*, the specifications of the patents-in-suit), the claims of the Cooper patents containing those terms never should have been allowed by the Patent Office. Cooper now asks this Court to construe

the claims by ascribing definitions to the claim terms resulting from discovery in post-issuance litigation. In other words, now that there is litigation, the Court is asked to *rewrite* Cooper's claims and to ignore the prosecution histories in doing so.

A. The patents-in-suit fail to define or enable the claim limitation "at least one degree of unsaturation."

With regard to the "at least one degree of unsaturation" claim limitation, Dr. Liotta stresses that ABB's position is that "each and every molecule of the vegetable oil must have at least one carbon-carbon double bond." Liotta Dec., ¶¶17-20. In actuality, ABB's position is that the Cooper patents fail to teach the public how to determine whether a given oil has (or does not have) "at least one degree of unsaturation."

Dr. Liotta suggests that "the term 'one degree of unsaturation' as understood by persons skilled in the art means that, *on average*, the fatty acids in the vegetable oil contain at least one carbon-carbon double bond." Liotta Dec., ¶18 (emphasis in original). But Dr. Liotta fails to explain, as Cooper's patents fail to explain, how to calculate the "degree of unsaturation" in a particular oil composition. He says that a typical 85% high-oleic oil has 3-5% saturates, 84-85% mono-unsaturates, 3-7% di-unsaturates and 1-3% tri-unsaturates, but he fails to explain, just as Cooper's patents fail to explain, how to determine whether the oil in fact *has* "at least one degree of unsaturation."

Dr. Angelo also states that the degree of unsaturation of a vegetable oil is the average number of double bonds in the fatty acid content of the triglycerides (Angelo Dec., ¶36) and provides *some* explanation of how an oil can be analyzed chemically, by measuring iodine value and using gas chromatography. He concludes that the degree of unsaturation of the vegetable oil can be calculated from this data in combination with widely available information on the carbons and double bonds. He and Dr. Liotta merely state the obvious: that fatty acids can be separated

and characterized chemically. While oils certainly can be analyzed for fatty acid content and double-bond distribution, the Cooper patents contain no teachings of how to determine from that analysis what the "degree of unsaturation" of the oil might be (*i.e.*, how can those diverse chemical characteristics, when determined, be used to ascertain the "degree of unsaturation?"). Neither of Cooper's alleged "experts," nor any of Cooper's patents, shed any light on this question. That is why these claim limitations are indefinite.

- B. The claim limitation "further comprising an oxygen scavenging material in contact with the dielectric fluid" recited in claim 23 of the '537 and '459 patents is indefinite in the context of underlying claim 22 of those patents.**

With regard to this claim limitation, as it appears in the '537 and '459 patents, Cooper presents three wordy and convoluted points (Cooper's Reply Brief, pp. 25-27) which boil down to the following:

1. Claim 19 of the '537 patent does not recite an oxygen scavenging material;
2. Because claim 23 of the '537 patent requires an oxygen scavenging material that is "dissolved in the dielectric fluid," that oxygen scavenging material "necessarily must be part of the dielectric fluid;" and
3. Claim 22 of the "does not contain a claim limitation which prohibits the oxygen scavenging material in contact with the dielectric fluid from also being *part* of the dielectric fluid" (emphasis in original).

Cooper's first two points are red herrings. They have no bearing on the logical inconsistency of this claim limitation which appears in claims 22 and 23 of each of the '537 and '459 patents and which Cooper does not rebut in its Reply Brief. Cooper's third point simply asserts that ABB is incorrect, but Cooper supplies no reasoning. Cooper cites cases supporting the long-established principle that new limitations cannot be read into claims through construction. Cooper fails to explain how an oxygen scavenging material that is "in contact with" the dielectric fluid (as required by claim 22) can be dissolved in (*i.e.*, part of) the dielectric

fluid (as required by claim 23 which depends on claim 22). Simply put, it cannot, for the same reason that one's right thumb cannot be "in contact with" his right hand. It is just part of it.

In addition, Cooper fails to even address the indefiniteness of claim 22 arising from the lack of any logical connection between the structural limitation "an oxygen scavenging material in contact with the dielectric fluid" and the "employing" step of independent claim 19. See ABB's Brief, pp. 61-63. It is no answer for Cooper to say this is a motion for summary judgment, which it is not, because if the Court is unable to ascertain the meaning of a claim, then the claim must be held indefinite as a matter of law—whether or not any party moves for summary judgment.

C. Cooper mischaracterizes *Ex Parte Hoffman*: it does not hold that "consisting essentially of" cannot be used to exclude an element specified in a dependent claim.

Under the facts of *Ex Parte Hoffman*, 12 U.S.P.Q.2d 1061, 1064 (Bd. Pat. App. 1989), 1989 WL 274371, the Board of Patent Appeals did find that a method step recited in a dependent claim was encompassed by the corresponding independent method claim. However, the Board did not articulate or rely on any rule that the phrase "consisting essentially of" cannot exclude elements that are expressly claimed by dependent claims, as Cooper argues. In addition, the method step at issue in that case was explicitly referred to in the identified dependent claim. In the present case, Cooper refers to a dependent claim that recites specific compounds but does not identify them as aromatics. Cooper's argument is that the Examiner must have known that the identified compounds were aromatics and allowed the claim anyway and that, therefore, the independent claim could not have excluded all aromatics. However, there is no evidence that the Examiner was aware that the compounds recited in dependent claim 10 are aromatics or even considered that issue. Certainly, Cooper did not inform the Examiner that the claimed compounds were the "aromatic compounds."

D. The patents-in-suit do not define or enable the claim limitations “free of chlorinated compounds” and “substantially free of chlorinated compounds.”

In its Reply Brief (pages 30-31), Cooper argues a new aspect of the “free of chlorinated compounds” limitation that is not recited in its patent claims or disclosed in any of its patents. Cooper says the limitation “free of chlorinated compounds” refers to vegetable oils “before they are put into the transformer.” *Cooper* talks of “virgin” oils: *Cooper’s patents* do not.

Cooper does not rebut ABB’s argument that the “free of chlorinated compounds” and “substantially free of chlorinated compounds” limitations constitute “new matter” introduced for the first time in Cooper’s CIP application for the ‘986 patent and are not entitled to the benefit of Cooper’s 1995 filing date.

CONCLUSION

For the foregoing reasons, the “food grade” and “natural food product” claim limitations are insolubly ambiguous and indefinite. Absent such a holding by the Court at this stage of these proceedings, the claims of the patents-in-suit should be construed as set forth in the following table:

<u>Claim Limitation</u>	<u>ABB's Alternative Proposed Construction</u>	<u>Claims Affected</u>			
		'537	'459	'986	'250
"a food grade dielectric fluid"					1-26 (all)
"wherein the [or said] dielectric fluid is food grade"	These limitations should be construed to exclude any dielectric fluid having a total antioxidant content above 0.02 wt. % or containing aromatic compounds, halogenated hydrocarbons, or alkylmethacrylates.			21-23 1-20	(all)
"an essentially food grade dielectric [insulating] fluid"		1-27 (all)			
"essentially a natural food product"	This limitation should be construed to mean that the entire dielectric fluid is required to be a "natural" and edible food, such that it contains no <i>synthetic</i> ingredients and is edible by humans.		1-27 (all)		
"A method of using"	This limitation should be construed not to cover manufacturing, offering for sale, selling, or importing of whatever is defined in the balance of the claim.	19-24	19-23 & 27	1-15 & 21	1-26 (all)
"having at least one degree of unsaturation"	This limitation should be construed to require that every molecule of the vegetable oil in the dielectric fluid have at least one degree of unsaturation.	19-24	19-23 & 27	3	
"further comprising an oxygen scavenging material in contact with the dielectric fluid"	This limitation should be construed to require an oxygen scavenging material that is not part of the dielectric fluid to be in contact with the dielectric fluid.	22 & 23	22 & 23		
"consisting [or consists] essentially of a vegetable oil..."	This limitation should be construed to exclude synthetic antioxidants and any other additive or ingredient that materially alters the basic and novel characteristics of what is claimed in the balance of the claim where it appears and any underlying claim(s).		1-27 (all)	1-23 (all)	1-26 (all)
"free of chlorinated compounds"	This limitation should be construed to exclude any dielectric fluid containing any chlorinated compound in any amount.			16-20, 22, & 23	
"substantially free of chlorinated compounds"	This limitation should be construed, if at all, to mean that no measurable amount of any compound containing chlorine can be detected in the vegetable oil employed in the claimed device.			1-15 & 21	1-26 (all)
"wherein said dielectric fluid further comprises an antioxidant compound"	This limitation should be construed to exclude any antioxidant compound that alters the basic and novel characteristics of the dielectric fluid defined in the balance of the claim where it appears and any underlying claim(s).			9 & 10	5, 6, 18 & 19

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Certificate of Service

I hereby certify that on August 26, 2004, I caused a true and correct copy of the foregoing
ABB'S BRIEF ON CLAIM CONSTRUCTION to be served via hand-delivery on:

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